

REMARKS

Claims 1-17 are pending in this application.

The Office Action dated May 19, 2005, has been received and carefully reviewed. In that Office Action, claims 1 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over the conventional art discussed in the specification (hereinafter "AAPA") in view of Birkler; claims 3, 5, 7, 9, 11, 13 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Birkler and further in view of Kuki; claims 2 and 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Birkler and further in view of Parvulescu; and claims 4, 6, 8, 10 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Birkler and Parvulescu and further in view of Kuki. It is respectfully submitted that a proper motivation to combine the references of record has not been provided, and that a *prima facie* case of obviousness has therefore not been presented. Furthermore, it is respectfully submitted that even if the references were combined, the result would not be, and would in no manner suggest, the claimed invention. Reconsideration of these rejections is respectfully requested in view of the following remarks.

STATEMENT OF SUBSTANCE OF INTERVIEW

The outstanding rejections were discussed with the examiner during a personal interview between Applicant's representative Scott Wakeman and Examiner Linh Son July 20, 2005. Also present at the interview were Mr. Yasuhiro Matsushima and Mr. Masanori Hara of the assignee, Sharp KK, and primary examiner Hosuk Song. Mr. Scott Wakeman and Examiner Son discussed the application further during a telephone interview later that same day. No exhibits were shown. Claim 1, Applicant's admitted prior art (referred to as "AAPA") and Birkler were discussed. Applicant argued that nothing in Birkler suggests modifying AAPA to produce the claimed invention. The examiner argued that Birkler's synchronization method in combination with AAPA renders the claimed invention obvious. No agreement was reached.

It is noted that the examiner would not provide an interview summary at the end of the personal interview. Instead, the examiner indicated that he wished to consider matters further and would call later that day and provide separate interview summaries for the personal and telephone interviews. Applicant's representative did not see the interview summaries until several days later. During the interview, the examiner argued that it would have been obvious to combine references;

Applicant's representative argued that the references did not show or suggest the invention. The examiner's interview summary, however, might be interpreted to suggest that Applicant's representative agreed with the examiner's arguments regarding obviousness. To that extent, Applicant's representative objects to the examiner's interview summary and submits that the above statement of the substance of the interview, as well as the below and previously presented arguments, reflect the position of Applicant.

A PROPER MOTIVATION FOR COMBINING
THE REFERENCES HAS NOT BEEN IDENTIFIED

Claim 1 requires, *inter alia*, communication means for automatic transmission and reception of an identification code and notification voice data. Claim 1 also requires that notification voice data stored in the notification voice data storage means of one of the first and second search devices be automatically transmitted to the other of the first and second search devices after an identification code match is detected so that the same notification voice is produced by the first search device and the second search device. The Office Action acknowledges that AAPA does not disclose these limitations. The Office Action, however, cites the Birkler reference to show a method of synchronizing databases in, for example, two handsets.

The motivation for making this combination is identified as "so that the right notification data correlated with the identification data can be sounded when the target device is in range. The correct notification will provide a sound identification of both parties when it is in range to hear." The Office Action does not identify what is the "right notification data" or the "correct notification." The prior art does not disclose a problem of "wrong" notifications, merely that different notification voices were used for different devices. The Office Action identifies an alleged result of combining the references but identifies nothing in the prior art that would lead one aware of the AAPA to make the improvement of the present invention. The statement "The correct notification voice will provide a sound identification of both parties when it is in range to hear" is a statement of a solution to a problem identified by the present applicant. It derives from the present disclosure and not from the prior art. Only with the hindsight benefit of the present disclosure would one skilled in the art arrive at the claimed invention. Because no motivation for combining AAPA and Birkler has been identified, a *prima facie* case of obviousness has not been presented, and claim 1 is submitted to be allowable over the art of record.

Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Birkler and further in view of Kuki. The motivation for making this combination of three references is “to provide multiple capabilities to operate in different scenarios.” The “multiple capabilities” and “different scenarios” are not identified. It is respectfully submitted that any two references will show “multiple capabilities,” but unless a motivation for combining the references is identified, the combination is improper and does not present a *prima facie* case of obviousness. Differences between the invention required by claim 13 and the devices disclosed in the prior art will be addressed once a *prima facie* case of obviousness is presented.

Claims 14-16 depend from claim 13 and are submitted to be allowable for at least the same reasons as claim 13.

Dependent claims 3, 5, 7, 9, 11 and 16 stand rejected under AAPA in view of Birkler and further in view of Kuki. The motivation for making this combination of three references is “to provide multiple capabilities to operate in different scenarios.” The “multiple capabilities” and “different scenarios” are not identified. It is respectfully submitted that any two references will show “multiple capabilities,” but unless a motivation for combining the references is identified, the combination is improper and does not present a *prima facie* case of obviousness. Claims 3, 5, 7, 9 and 11 are submitted to be allowable for at least this reason and based on their dependence from claim 1. Claim 16 is submitted to be allowable for at least this reason and based on its dependence on claim 13.

Dependent claims 2, 14 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Birkler and further in view of Parvulescu. The motivation for making this combination is that it will “provide a flexible, and organize solution to the user to operate the device in difference scenarios.” The “different scenarios” are not identified. A motivation for using a device in different scenarios is not identified. A motivation for making a device “flexible” is not identified. It is respectfully submitted that a motivation for making the above combination of references has not been provided, that therefore a *prima facie* case of obviousness has not been presented in connection with the above claims, and that these claims are allowable over the art of record.

Claims 4, 6, 8, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Birkler and further in view of Kuki and further in view of Parvulescu. The motivation for making combining these four references is either to “provide a flexible, and organize

solution to the user to operate the device in different scenarios” (claim 4) or “provide multiple capabilities to operate in different scenarios” (claims 6 and 8). For the reasons provided above, it is respectfully submitted that a *prima facie* case of obviousness has not been presented and that claims 4, 6, 8, 10 and 12 are allowable over the art of record.

THE REFERENCES DO NOT SHOW OR SUGGEST THE CLAIMED INVENTION

Even if a proper motivation for combining the references were provided, it is respectfully submitted that the cited combination of references does not show or suggest the invention required by claim 1. Birkler teaches that databases can be synchronized, that is, the data in one database can be made consistent with data in a second database so that both databases contain the same information. This generally occurs after one of two databases that are supposed to contain identical information is updated. Recent changes to one database are then made in the second database. In AARP, no database is out of date. Each device includes stored notification voice data. The information in each device is “correct” for that device. If the databases were “synchronized,” one device would have its data overwritten by data from the other device. Thus, one user would lose previously stored data and still not know which notification voice to use for a given meeting. It is respectfully submitted that combining the references as has been proposed by the examiner would not result in, and in no manner suggests, the claimed invention.

Claims 2-12 depend from claim 1 and are submitted to be allowable for the same reasons as claim 1.

Claim 17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Birkler. Claim 17 is submitted to be allowable for at least the same reasons provided above in connection with claim 1.

Claim 13 stands rejected as being unpatentable over AAPA in view of Birkler and further in view of Kuki. Each step required by claim 13 is not shown or suggested by the references of record. Therefore, even if a proper motivation for combining the references were shown, the result would not be and would in no manner suggest the invention required by claim 13.

CONCLUSION

Each issue raised in the Office Action dated May 19, 2005, has been addressed, and it is believed that claims 1-17 are now in condition for allowance. Wherefore, reconsideration and

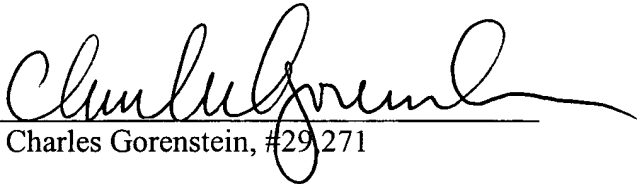
allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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